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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1964

No. 869

IN THE MATTER OF THE APPLICATION OF HOMER G. THOMSON

ANNEX TO PETITION FOR WRIT OF CERTIORARI OF HOMER G. THOMSON

Containing analysis of conflicting decisions of the Court of Customs and Patent Appeals

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ANALYSIS OF DECISIONS PERTAINING TO THE SCOPE OF REVIEW AND JURISDICTION IN APPEALS TO THE COURT OF CUSTOMS AND PATENT APPEALS IN PATENT CASES

INTRODUCTION

The following analysis of about one hundred and fifty decisions of the Court of Customs and Patent Appeals (hereafter referred to as the CCPA) pertaining to its jurisdiction and scope of review in patent cases is prepared for the purpose of providing a comprehensive view of the body of law developed by the CCPA on

these questions, since it received the patent appeals jurisdiction by the Congressional Act of March 2, 1929. Preferably such an analysis would be completely exhaustive of all of the CCPA's decisions on these matters. However, the digests are not sufficient for such a task, so the most that can be said is that, although no effort was spared to make the collection of cases perfectly complete, it is no more than extensive and representative.

The organization of these cases is based upon statutory language, although the CCPA has seldom referred to the statute in these matters. Also, some decisions may state, for example, that such-and-such evidence cannot be considered by the Court because it was not considered below, and because the issue raised by the evidence was not decided below so there is nothing to review, and because there is no reason of appeal citing the matter, and these declarations of law are followed by several paragraphs analyzing that evidence, and the decision ends stating that even if the evidence could have been considered it was not sufficient on the merits to change the decision. In such situations the case is usually treated here for each of the jurisdictional limitations noted by the CCPA.

I. THE RECORD ON APPEAL

A. "The Commissioner shall transmit to the Court certified copies of all necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee, * * *" 35 USC 143

1. Can the CCPA consider any evidence that has not been certified to it by the Commissioner?

   a. In the present case no evidence was certified to the CCPA as to similarity of operation of the

various terminal heads shown in the prior art. Also, in this case the CCPA made a finding as to the types of terminal heads *conventionally employed* in the resistor art, though there was no evidence certified to it from the Commissioner on that matter. Whatever the majority of the CCPA may have relied upon to reach its conclusions raises the question in this case as to whether it was authorized to go beyond the evidence certified to it.

b. The CCPA has stated unequivocally that it may not as a matter of law consider evidence not certified to it, even though the evidence proffered may have been produced before the Patent Office. Exemplary of the type of evidence thus rejected by the CCPA are the following: *In re Savage,* 27 CCPA 1048, 45 USPQ 155, 159 (1940), a copy of a drawing of a patent cited below; *Foss v. Oglesby, Reilly and Gilbert,* 29 CCPA 1005, 53 USPQ 357, 361 (1942), a patent cited below; *In re Buser,* 29 CCPA 1196, 54 USPQ 319, 321 (1942), a patent, decisions from foreign patent offices and a drawing of a commercial embodiment of the invention; *In re Lindenblad,* 35 CCPA 1132, 168 F. 2d 110, 77 USPQ 604, 606 (1948), a British patent; *In re Watson,* 36 CCPA 1132, 82 USPQ 177 (1949), patents; and *In re LeBaron,* 42 CCPA 956, 106 USPQ 176, 178 (1955), a patent. In the case of *McKesson & Robbins, Inc. (William J. Wardall, Trustee, substituted) v. Leonard James Co.,* 29 CCPA 1137, 54 USPQ 207, 212 (1942), it is not clear whether the court refused to consider the disclaimer filed

before the Board of Appeals because it was not evidence produced before the Patent Office, or whether because it was not certified as a part of the record.

c. However, the CCPA has also held that it may take judicial notice of evidence which was not certified to it. The CCPA asserted this as a rule in the first year after the Patent Appeals jurisdiction was transferred to it in *In re Kochendorfer,* 7 USPQ 209, 210 (1930),

> "* * * The statute requires that we shall review decisions appealed from on the evidence produced before the Patent Office, and we cannot consider any facts that are not found in the record or of which we cannot take judicial notice."

2. What kind of evidence has been recognized as authentic without certification by the Commissioner?

a. The CCPA has not accepted patents not certified to it. In one of the early cases before the court, the solicitor for the Patent Office attempted to induce the court to take judicial notice of a patent which had not been before the Patent Office for the purpose of affirming a rejection of the claims, but the court refused to do so, *In re Coley,* 5 USPQ 281, 285 (CCPA 1930). In 1963, an appellant sought to introduce a patent in the court which had not been before the Patent Office for the purpose of arguing the patentability of his design, but the court refused to take judicial notice of the pat-

ent. *In re Phillips,* 50 CCPA 1223, 137 USPQ 369, 370 (1963)

b. The CCPA also indicated some doubt as to the authenticity of a government publication inserted in an appendix to a brief and did not consider, though its main reason for refusing to consider the document may have been because its contents had not been produced before the Patent Office. *In re Chandler and Wright,* 50 CCPA 1422, 138 USPQ 138, 145 (1963)

c. However, the CCPA has accepted privately published literature such as encyclopedias, *In re Replogle,* 27 CCPA 704, 43 USPQ 402 (1939); technical treatises and handbooks, *In re Egan, Leydon and Fahey,* 34 CCPA 34, 72 USPQ 442, 444 (1947); and *In re Curley and Kilbourne,* 34 CCPA 749, 72 USPQ 116 (1947).

B. "The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, * * * ." 35 USC 144.

1. Can the CCPA make findings without evidence to support them?

a. In view of the above mentioned findings which the majority of the CCPA made in this case, where there is no evidence to support them, it becomes pertinent to inquire whether evidence is necessary.

b. The CCPA has held that it cannot make findings unless there is evidence of record to support such findings. Frequently the issue has arisen over an allegation of commercial success,

and the CCPA has held that it will not consider allegations made in the brief unless they are supported by evidence in the record. *In re Beeson,* 26 CCPA 755, 40 USPQ 122 (1938); *In re Sherron,* 46 CCPA 768, 120 USPQ 471 (1959). This was clearly stated in *In re Britton,* 28 CCPA 726, 47 USPQ 265 (1940), where the court stated on page 270:

> "Appellant's brief is replete with statements of fact respecting the commercial success of appellant's composition. There is nothing in the record on this point, and such statements should not have been included in appellant's brief."

In *In re Kochendorfer,* 7 USPQ 209, 210 (1930) the CCPA refused to accept unsupported statements in the record, made by both the appellant and the examiner that appellant's machine was the finest one available. In 1962, an appellant seeking registration of its trademark attempted to appraise the court of the general nature of the market and commerce involved, by including a description of it in its brief, but the court refused to consider it, saying:

> "A section of appellant's brief entitled 'Commercial Facts' deals with the business of appellant, the nature of the goods it allegedly sells, and the purchasers who buy them, urging that they would be discriminating. We have no way of knowing the truth of any of the matters stated since the record is devoid of supporting evidence. * * *" *In re Burndy Corp.,* 49 CCPA 967, 133 USPQ 196, 197 (CCPA 1962)

Similarly, where the CCPA has commented on its competency to consider the operation of de-

vices shown in the prior art, it has often held that it may not do so, unless these matters are supported by evidence of record. *In re Elliott and Joslyn*, 47 CCPA 809, 125 USPQ 135, 137 (1960); See also, *In re Reynaud*, 51 CCPA —, 141 USPQ 515, 518 (1964). *In re Mercier*, 36 CCPA 971, 81 USPQ 210 (1949), the appellant charged that the teachings of one of the references were impracticable but the court responded at 81 USPQ 211,

> "* * * There is no evidence of such impracticability in the record, and the statement of counsel may not be considered as a substitute therefor * * *."

In 1952 the court refused to consider an appellant's allegation as to the operation of certain aspects of his own invention as disclosed, since these allegations were not supported by evidence of record outside of the application. *In re Madsen and Goodson*, 39 CCPA 1008, 94 USPQ 186, 188 (1952). In a 1962 patent interference appeal, the appellant challenged the operability of the appellee's disclosure, but the court refused to consider it. *Rodin v. Spalding*, 49 CCPA 870, 132 USPQ 285, 288 (1962)

2. But the CCPA has made findings on the basis of its own experience, without benefit of other evidence, under the cloak of judicial notice. *Derby Oil Co. v. White Star Refining Co.*, 20 CCPA 816, 16 USPQ 297, at 300 (CCPA 1933) the court made extensive findings on judicial notice that the products of both parties, petroleum and petroleum derivatives, were retailed almost exclusively at service and filling stations, and recited what prob-

lems it thus found involved in merchandising these articles and the effects of trademarks. Although, eight years later in a trademark opposition proceeding, the court refused to take judicial notice that one of the products, a rust solvent, could also be used as a rust preventative for ball bearings and ball bearing devices. *Norma-Hoffmann Bearings Corp. v. Hufnagel,* 29 CCPA 32, 51 USPQ 466 (1941). The court on its own motion took judicial notice that foot-operated electrical switches had long been in use in lights and automobiles as well as in automobile starters to affirm a rejection by the Patent Office of claims pertaining to a control for a machine tool. *In re Goldberg,* 35 CCPA 1225, 78 USPQ 69, 73 (1948).

3. The CCPA has declared many times that it will not consider evidence which had not been presented to the Patent Office tribunals.

   a. The CCPA has held as a matter of law that it cannot consider patents which were not presented to the Patent Office tribunals. *McBride v. Teeple, Jr.,* 27 CCPA 961, 44 USPQ 523, 533 (CCPA 1940) (cert. den. 47 USPQ 531); *In re Taylerson,* 31 CCPA 1025, 61 USPQ 352, 355 (1944); *Martin and Kinkaide v. Snyder,* 41 CCPA 1010, 102 USPQ 306, 308 (1954); and *In re Harris and McCane,* 51 CCPA 786, 139 USPQ 292, 296 (1963). The doctrine of judicial notice was held inadequate to bring before the CCPA a reference not cited by the Patent Office tribunals in *In re Coley,* 5 USPQ 281, 285 (1930); *In re Phillips,* 50 CCPA 1223, 137 USPQ 369, 370 (1963).

b. The CCPA has also refused to consider on appeal evidence of commercial success never before presented in the case. In 1963 the court refused to consider an appellant's allegation as to the practical value of his invention, saying, in *In re Chandler and Wright,* 50 CCPA 1422, 138 USPQ 138, 145 (1963):

> "Insofar as disclosed by the record, the assertion relating to the Government's adoption and use is made here for the first time. Since this averment, allegedly supported by the document in 'Appendix A,' referred to as official U. S. Government publication, was not before the tribunal below for its consideration, we will not consider it. *In re Reese,* 48 CCPA 1015, 290 F. 2d 839, 129 USPQ 402 * * *."

4. There is some question, however, as to what is necessary to produce a document as evidence before the Patent Office. In *In re Lambooy,* 49 CCPA 985, 133 USPQ 270 (1962), a journal article had been referred to by the appellant in a communication to the examiner and had been relied upon by the Board of Appeals, but the CCPA held that the article was not of record and refused to consider it. On the other hand, the CCPA once considered a patent of record, since it was referred to in one of the prior art references cited by the Patent Office tribunals. *In re Walker and Jacobsson,* 30 CCPA 1072, 57 USPQ 533 (1943).

5. Nevertheless, there remains the doctrine of judicial notice which the CCPA has invoked to consider evidence which was not presented to the Patent Office tribunals. In a patent appeal from a rejection of the claims by the Board of Appeals the court took judicial notice of common practices in

packaging cigarettes on the basis of an article in a popular encyclopedia. *In re Replogle,* 27 CCPA 704, 43 USPQ 402 (1939). In 1947, the court took judicial notice of the solubility of "neutral soaps" in water on the basis of a treatise cited to it, in partial contradiction of the statement by an examiner. *In re Egan, Leydon and Fahey,* 34 CCPA 34, 72 USPQ 442, 444 (1947). However, in 1962 the court refused to take judicial notice of a monograph on a chemical question. *In re Petering and Fall,* 49 CCPA 993, 133 USPQ 275, 279 (1962). Also, the court refused to take judicial notice as to the meaning of the word "contacting" in the particular art involved in a patent interference proceedings. *Bray and Swift v. Tears,* 26 CCPA 1103, 41 USPQ 321, 325 (1939). If there is a rationale for these conflicting decisions, it is not the usual one of the public notoriety of the information concerned, but rather it seems to be the CCPA's confidence or lack of confidence in its own ability to understand and evaluate the information involved.

6. Is the evidence "produced" before the Patent Office limited to the evidence relied upon by the Patent Office tribunals for the specific decision and reasoning appealed from? In the present case there was no reliance placed on the Kohring patent in the Patent Office, but the majority's decision in the CCPA would fall without it.

   a. Nevertheless, the CCPA has frequently indicated that it cannot consider evidence not relied on by the Patent Office tribunals. It is not clear in such cases whether the CCPA is thus limited because there is no decision on that evidence to review, or whether the statutory language of

"produced before" is being construed to mean "relied upon" or "applied". Since the CCPA has so frequently been explicit in cases where it has asserted limitations based on the scope of the decisions below, these cases where it has rejected evidence on the terse statement to the effect that the evidence was not considered or relied on below are taken to mean that the scope of the admissible record on appeal is also limited by the decision below.

The CCPA has sometimes held as a matter of law that it may not consider prior art or other evidence of record which the Board of Appeals refused to consider. Where the Board of Appeals has held that certain prior art may not be properly cited against the application, the Court has held that it is precluded from considering it. *In re Mills*, 47 CCPA 1187, 126 USPQ 513, 515 (1960). Also, patents asserted by the examiner in connection with a reason for rejection subsequently reversed by the Board of Appeals, it has been held, may not be considered by the CCPA on appeal. *In re Schwarz*, 28 CCPA 943, 48 USPQ 564 (1941); *In re Upson*, 34 CCPA 1022, 73 USPQ 401, 402 (1947); *In re Bourdon*, 44 CCPA 740, 112 USPQ 323, 324 (1957). Recently the CCPA refused to consider a patent cited by the examiner in the final rejection, but withdrawn by the examiner in his answer to appellant's brief on appeal to the Board of Appeals. *In re Flint*, 51 CCPA 1230, 141 USPQ 299, note 300 (1964). Also, the Court has held it may not properly consider affidavits of record which the Board of Appeals refused to consider.

In re Ayers, 33 CCPA 874, 69 USPQ 109 (1946); *In re Britton*, 38 CCPA 726, 47 USPQ 265, 270 (1940); *In re Gartner and Roeber*, 42 CCPA 1022, 106 USPQ 273, 275 (1955).

Last year, the Court seems to have gone even further stating that it could not look at any patent office decision in the case, except those rejections of the claims on appeal asserted or affirmed by the Board of Appeals, *In re Melott*, 51 CCPA —, 141 USPQ 579 (1964). In the *Melott* case the appellant, in an effort to persuade the Court that the rejection of the claims over the prior art cited was by no means free from doubt, sought to have the Court review earlier actions by the examiner in which the examiner had held the claims allowable over those references, although the examiner later apparently reversed his position. The majority of the Court held, as a matter of law, that it could not look at those actions of the examiner.

The CCPA has even held that it cannot consider appellant's descriptions of prior art in his application, if it was not mentioned by the Patent Office tribunals. *In re Bayard*, 46 CCPA 951, 122 USPQ 520, 522 (1959); *In re Hunter*, 48 CCPA 822, 128 USPQ 544, 546 (1961). Similarly, a patent relied upon by an appellant but given no mention by the Patent Office tribunals was expressly ignored in *Foss v. Oglesby, Reilly and Gilbert*, 29 CCPA 1005, 53 USPQ 357, 361 (1942). In a more recent case, the CCPA held that it could not consider patents made of record by appellant, but not considered by the Patent Office tribunals. *In re Chaplin*, 44 CCPA 941,

114 USPQ 157, 160 (1957). Where the Patent Office had rejected claims as being improperly drafted in product-by-process form for the reason that applicant did not disclose a process for making the specific products claimed, the Court refused to examine the disclosure anew to decide whether such a process was disclosed, for the stated reason that to do so would call for their deciding, *de novo*, technical matters which had not been before the Patent Office tribunals. *In re Wohnsiedler and Ammondson*, 50 CCPA 1153, 137 USPQ 336, 338 (1963).

Most frequently, the Court has stated that prior art not relied upon by both Patent Office tribunals, or not specifically applied by the Patent Office tribunals to the claims on appeal, need not be considered by the Court and hence is ignored. *In re Fitzgerald*, 25 USPQ 114, 116 (1935); *In re Buckwalter*, 27 CCPA 1002, 44 USPQ 593, 594 (1940); *In re Pinkerton*, 28 CCPA 803, 47 USPQ 468, 470 (1940); *In re Farnum*, 28 CCPA 1245, 49 USPQ 671, 672, (1941); *In re Otto and Heinrich*, 28 CCPA 1326, 50 USPQ 149 (1941); *In re Walker and Jacobsson*, 30 CCPA 1072, 57 USPQ 533, (1943); *In re Ayers*, 33 CCPA 874, 69 USPQ 109, 110 (1946); *In re Moore*, 33 CCPA 1083, 69 USPQ 524 (1946); *In re Lindenblad*, 35 CCPA 1132, 168 F. 2d 110, 77 USPQ 604, 607 (1948); *In re Shortell*, 36 CCPA 1013, 81 USPQ 359, 360 (1949); *In re Watson*, 36 CCPA 1132, 82 USPQ 177 (1949); *In re Horvath*, 41 CCPA 844, 101 USPQ 191, 192, 193 (1954); *In re Libby*, 45 CCPA 944, 118 USPQ 94, 95

(1958); *In re Touvay and Martin,* 46 CCPA 823, 121 USPQ 265, 266 (1959).

b. On the other hand, the CCPA has also frequently held that it is not limited by the decision of the Patent Office tribunals and that it may consider all the evidence presented in the Patent Office and apply parts of prior art publications or other evidence not previously mentioned. The CCPA has held that it is free to utilize portions of references never before relied upon by the Patent Office tribunals in affirming the rejection of the Patent Office, *In re Halley,* 49 CCPA 793, 132 USPQ 16, 20 (1962). In *In re Stinson,* 33 CCPA 853, 69 USPQ 81, 82 (1946), the Court held that it was proper for it to consider a prior art patent claim as a disclosure, which claim had not been referred to in the Patent Office. Similarly, in *In re Hall,* 41 CCPA 759, 100 USPQ 46, 48 (1953) the Court preferred to rely upon a portion of a prior art patent which had not been referred to by the Patent Office tribunals. Again, in 1957, in the case of *In re Azorlosa,* 44 CCPA 826, 113 USPQ 156, 158 (1957), the Court preferred to rely upon a portion of certain references not considered below and to rely upon these references in a different way, stressing that its jurisdiction was confined to only the evidence produced before the Patent Office and that the issue before it was the patentability of the claims over the evidence. Also, where the issue as to the adequacy of the disclosure to support the claims had been controverted both with the examiner and before the Board of Appeals on one portion of the dis-

closure, the Court expressed no hesitancy to look to another portion of the disclosure which had not been considered by the Patent Office tribunals to find sufficient additional material to support the claims. *In re Adams, Kirk and Petrow,* 50 CCPA 1185, 137 USPQ 333, 334 (1963). That case involved highly technical questions pertaining to steroid chemistry, but the Court held that since the disclosure was part of the evidence on appeal it was not a new issue to refer to a new part of it never considered by the Patent Office tribunals.

II. THE DECISIONS OF THE PATENT OFFICE TRIBUNALS

A. "An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeal, * * *" 35 USC 141

1. Is the "decision" reviewed limited to the expressed statements of the Board of Appeals?

a. The CCPA's description of what it reviews would indicate that the only decisions before it are the expressions of the Board of Appeals that respond to the Reasons of Appeal stated by appellant. In one of the landmark decisions handed down by a tribunal exercising the patent appeals jurisdiction, Judge Cranch declared that the scope of review of that jurisdiction was strictly limited to the Commissioner's response to an appellant's reasons of appeal. *Arnold v. Bishop et al,* 1 Fed. Cas. 1168, Case No. 553 (1841). Judge Cranch applied that ruling in *In re Aiken,* 1 Fed. Cas. 226, Case No. 107

(1850). The CCPA quoted at length from the pertinent portion of *Arnold v. Bishop et al,* supra., in another landmark case, *In re Tucker and Reeves,* 19 CCPA 810, 12 USPQ 131 (1932). The CCPA referred to that portion of the *In re Tucker et al* decision as authority for its decision in *In re Sebald,* 31 CCPA 1148, 62 USPQ 90, at 92 (1944) stating that "* * * we followed the holding of Judge Cranch * * *".

b. In truth, the CCPA has *not* followed the holding of Judge Cranch and has repeatedly held that on appeal it reviews, not only the express decision of the Board of Appeals, but every decision of the examiner that the Board has not expressly reversed, even though the Board may not have mentioned it. *In re Wagenhorst,* 20 CCPA 991, 17 USPQ 330 (1933); *In re Boyce,* 32 CCPA 718, 63 USPQ 80 (1944), and the twenty-seven decisions cited at 63 USPQ 81; *In re Dalzell and Wyman,* 32 CCPA 938, 65 USPQ 215 (1945); *In re Smith,* 32 CCPA 1256, 66 USPQ 306 (1945); *In re Glocker,* 33 CCPA 789, 68 USPQ 194 (1946); *In re Voit and Weimer,* 33 CCPA 737, 68 USPQ 206 (1946); *In re Scharf,* 33 CCPA 1079, 69 USPQ 518 (1946); *In re Russell,* 34 CCPA 721, 71 USPQ 85 (1946); *In re Emmey and Katzenstein,* 34 CCPA 1097, 74 USPQ 38 (1947); *In re Ray,* 35 CCPA 1088, 77 USPQ 375 (1948); *In re Booge and Seidel,* 37 CCPA 927, 84 USPQ 482 (1950); *In re Strain,* 38 CCPA 933, 89 USPQ 156 (1951); *In re Clark,* 41 CCPA 974, 102 USPQ 241 (1954).

B. "* * * in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal." 35 USC 143

1. Can the CCPA affirm the decision of the Board of Appeals for reasons other than "the grounds of the decision of the Patent Office?"

a. The CCPA has held many times that it may *not* affirm the decision of the Board of Appeals for reasons other than those relied upon in the Patent Office. Since the CCPA in the present case has clearly relied upon grounds not assigned in the Patent Office in finding a reason for combining the references, in relying upon the Kohring patent and in making the various findings mentioned previously, it becomes pertinent to inquire whether it can do so.

To begin with, the CCPA has often held that it may not review reasons of rejection asserted by the examiner, but specifically reversed by the Board of Appeals. *In re Dubbs,* 25 USPQ 396 (CCPA 1935); *In re Murray,* 25 USPQ 349 (CCPA 1935) (citing *In re Wagenhorst, supra.*); *In re Michlin,* 45 CCPA 1028, 118 USPQ 353 (1958); and *In re Dean,* 48 CCPA 1072, 130 USPQ 107 (1961). The Court has repeatedly held that it will not consider a new reason for rejection not raised by the Patent Office tribunals, in cases where the new reason involved a section of the statute different from that apparently relied upon by the Board of Appeals in order to sustain a contention of unpatentability. For example, in cases where the Patent

Office had held that the claims were not allowable for the reason that they were unpatentable over the prior art (now 35 USC 103) the CCPA has refused to reject the claims for the reason that they were drawn to an aggregation, *In re Henatsch,* 49 CCPA —, 132 USPQ 445, note p. 449 (1962); the claims were too broad, *In re Bronson,* 24 USPQ 213, 215 (1935); the claims were not supported by the disclosure, they were too broad and they were not properly drawn, *In re Peiler,* 20 CCPA 453, 17 USPQ 453, 457 (1933); an element of the claim relied upon for novelty was not supported by the disclosure, *In re Dilnot,* 49 CCPA 1015, 133 USPQ 289, 291 (1962); the claims are indefinite, *In re Fleissner,* 46 CCPA 831, 121 USPQ 270, 272 (1959); the claims failed to satisfy Section 112, *In re Steele, Mills, and Leis,* 49 CCPA 1295, 134 USPQ 292, 295 (1962).

Also, where the Patent Office has rejected the claims as being completely anticipated by a prior art teaching, which would be a rejection based on Section 102 of the 1952 Act, and the Court has found the prior art teaching to be lacking some necessary element, the Court has refused to consider whether the difference between the prior art teaching and the invention claimed is sufficient to be patentable (before 1952, contained invention; after 1952, 35 USC 103, was obvious) *In re Heltzer,* 38 CCPA 1124, 90 USPQ 92, 96 (1951); *In re Gregg,* 44 CCPA 904, 113 USPQ 527, 529 (1957); *In re Turlay,* 49 CCPA 1288, 134 USPQ 355, 360 (1962).

The Court has also refused to consider whether the invention claimed would be patentable (35

USC 103) on the merits over the prior art cited, in cases where the Patent Office has rejected those claims for double patenting, *In re Davis and Swoope,* 29 CCPA 23, 123 F. 2d 651, 51 USPQ 458, 463-464 (1941); on a requirement for division, *In re Krasnow,* 33 CCPA 764, 68 USPQ 210, 214 (1946); for being drawn to an aggregation, *In re Worrest,* 40 CCPA 804, 201 F. 2d 930, 96 USPQ 381, 387 (1953); and for not being supported by the disclosure, *In re Crabtree,* 24 USPQ 248, 251 (1935).

Finally, in a case where the Patent Office had rejected the claims on appeal as not being supported by the disclosure, and one of those claims was dependent on another claim that was not on appeal and that had been rejected as being unpatentable over the prior art, the Court refused to affirm the rejection of the dependent claim either for its obvious shortcomings in form or its unpatentability. *In re Franck and Schettini,* 45 CCPA 975, 118 USPQ 284, 287 (1958). The Court has also refused to consider potential grounds for unpatentability which were raised before the Patent Office tribunals and the Court by the appellant, since the Patent Office had refused to cite those reasons for rejection. *In re Savage,* 27 CCPA 1048, 45 USPQ 155 (1940). The case *In re Kalter,* 50 CCPA 1191, 137 USPQ 347 (1963), presents an example of the refusal of the CCPA to assert a reason for rejection not raised in the Patent Office applied in a situation where the same statutory provision was the basis for both the Board's rejection and the newly proposed rejection. In the *Kalter* case, claims

8 and 9 pertaining to bicycle seats had been rejected on 35 USC 103 as being unpatentable over different references. The Board of Appeals interpreted claim 8 as being drawn to a first embodiment of the invention as shown in Fig. 4 of the application, and claim 9 as being drawn to a second embodiment of the invention as shown in Fig 5. The Court of Customs and Patent Appeals found the Board of Appeals to have erred in its interpretation of claim 9, and held that claim 9 was drawn to the same embodiment of the invention as claim 8 which was shown in Fig. 4. Of the two claims, claim 9 was admittedly the broader. The Court affirmed the rejection of claim 8 on the Mellano reference cited for it by the Patent Office, but the Court reversed the Patent Office rejection of claim 9, holding that the differences between the structure of claim 9 and the teachings of the specific prior art patent cited against it by the Patent Office would not have been obvious to one skilled in the art, although as a matter of simple logic claim 9 must also be unpatentable over the Mellano reference. But the CCPA refused to take that inevitable step, saying:

> "Appealing as this argument may be, a rejection of claim 9 based on Mellano is not before us. Only claim 8 was rejected on Mellano. We are without authority to advance new grounds of rejection, but are limited to deciding the issues before us." 137 USPQ 349

The *Kalter* decision, *supra.*, is consistent with the decision in *In re Mork*, 33 CCPA 1048, 69 USPQ 527, 530 (1946) where the appellant

charged that the Patent Office had thoroughly confused the entire matter, and urged the Court to ignore what the Patent Office had done, start anew and apply the prior art cited to the claims. The Court indignantly refused to "start from scratch" as recommended by appellant, Mork, saying on page 530:

> "* * * The suggestion is somewhat novel to say the least of it. It would seem to require that the court assume the functions of the Primary Examiner which we may not do. The statute defines our duty and limits our authority. We are required to review the decision of the board affirming the decision of the examiner when that decision is adverse to an appellant, and our review must be confined to the errors alleged in the reasons of appeal. Obviously, we cannot disregard a decision and at the same time review it."

The Court has applied similar reasoning in a succession of cases, such as in *In re Jacobi*, 17 USPQ 369, 370-371 (1933) where the CCPA refused to consider a contention that certain structure set forth in one claim was equivalent to the structure shown in his disclosure; in *In re Horton*, 12 USPQ 221, 224 (1932) where it refused to consider appellant's contention that the Board had erred in holding that certain subject matter of the claims was equivalent to the prior art; *In re Lawson*, 22 CCPA 1016, 75 F. 2d 633, 24 USPQ 419, 421 (1935) where it refused to consider whether portions of the claims were the same as that in an issued patent; *In re Hartung*, 28 CCPA 1364, 50 USPQ 151, 152 (1941) where it refused to consider the examin-

er's finding because the Board had not done so; in *In re Goldberg*, 35 CCPA 1225, 168 F. 2d 527, 78 USPQ 69, 73 (1948) where the CCPA refused to consider whether one of the prior art patents did show a portion of the claimed structure; *In re Weiskopf*, 41 CCPA 777, 100 USPQ 383, 385 (1954), where it refused to consider a contention that certain of the examiner's findings were erroneous; *In re Panagrossi and Hauser*, 47 CCPA 906, 125 USPQ 410-413 (1960), where the CCPA refused to consider whether or not a claim from an earlier parent application provided adequate disclosure to support claims in his continuation application, since that had not been raised below; *In re Grine* 48 CCPA 852, 129 USPQ 61, 63 (1961) where it refused to consider whether one of the references disclosed an operative apparatus. Accordingly, the Court has also held that it cannot consider the patentability of claims, where the question had not been decided by the Patent Office tribunals. *In re Schwendt*, 26 CCPA 1133, 41 USPQ 302, 303 (1939); *In re Taylerson*, 31 CCPA 1025, 61 USPQ 352, 355 (1944); *In re Smitley*, 49 CCPA 803, 132 USPQ 3, 6 (1962); *In re Tamarin*, 38 CCPA 872, 88 USPQ 490 (1951); *In re Lundberg and Zuschlag*, 44 CCPA 909, 113 USPQ 530, 533 (1957).

The Court has also refused to consider an interpretation of the claims, or a definition of a term in the claims, or elements of the claims as related to the prior art where the Board of Appeals has not expressly considered the matter. *In re Davis*, 26 CCPA 1249, 41 USPQ 674,

676 (1939); *In re Eitzen*, 24 CCPA 798, 32 USPQ 74; *In re Freedlander*, 31 CCPA 1199, 143 F. 2d 982, 62 USPQ 309, 311 (1944); *In re Saunders and Raymond*, 33 CCPA 1001, 154 F. 2d 693, 69 USPQ 341, 342 (1946); *In re Herthel*, 36 CCPA 1095, 82 USPQ 55, 57 (1949); *In re Horneman, Hussong, Quam and Hammer*, 39 CCPA 809, 92 USPQ 316, 321 (1952); *In re Storrs*, 44 CCPA 981, 114 USPQ 293, 298 (1957); *In re Allen*, 51 CCPA 809, 139 USPQ 492, 496 (1963); *Mitchell v. Hennion*, 31 CCPA 1129, 143 F. 2d 623, 62 USPQ 81, 87-88 (1944).

Although it might be supposed that points of law would be in the particular competence of the CCPA to decide, whether or not they were raised below, the CCPA has *not* so held. *In re Gray*, 45 CCPA 777, 116 USPQ 411, 413 (1958). In *In re Josserand v. Taylor, Jr.*, 31 CCPA —, 59 USPQ 140, 148 (1943) the CCPA refused to consider a question of admissibility of evidence, and it has also refused to pass upon the question raised by the solicitor as to whether appellant's specification may be utilized to show what the prior art knew as to the equivalency between certain compounds. *In re Ruff and Dukeshire*, 45 CCPA 1037, 118 USPQ 340, 348 (1958).

In interference cases, the CCPA has also refused to consider matters not raised below, such as the contention of one party that the opponent could not make the count. *Heddon v. Cowdery and Kinnear*, 26 CCPA 743, 40 USPQ 124, 125 (1938); *Brock v. Wittmann*, 26 CCPA 1191,

41 USPQ 473, 475 (1939); *Fernandez v. Gillman, Jr.*, 26 CCPA 1124, 41 USPQ 297, 300 (1939); *Rava v. Charlton*, 26 CCPA 1398, 42 USPQ 150, 151 (1939); and *Paivinen v. Sands*, 52 CCPA —, 144 USPQ 1, 4 (1964).

In McBride v. Teeple, Jr., 27 CCPA 961, 44 USPQ 523, 532 (1940) (Cert. den. 47 USPQ 531) the Court held that it could not consider a question of diligence not previously decided upon by the Patent Office tribunals and remanded the case to the Patent Office for the purpose of deciding that issue. The Court also refused to consider the question of derivation which had not been decided by the Patent Office tribunals in *Clark v. Camras*, 40 CCPA 963, 97 USPQ 434, 441 (1953). The Court refused to review the question of priority on the basis of evidence of record which had not been relied upon by the Patent Office tribunals. *Walsh v. Schultz and Steinmayer*, 26 CCPA 1184, 41 USPQ 499, 500 (1939).

In trademark cases, the CCPA stated in the case of *In re Tucker and Reeves, supra*, that it was not bound by the same considerations as it was in patent cases, but twelve years later in the case entitled *In re Retail Clerks International Protective Assn.*, 32 CCPA 1004, 65 USPQ 374, 376 (1945), the CCPA declared that the same rules governing the patent cases applied equally well to trademark cases. In *Mishawaka Rubber & Woolen Mfg. Co. v. The H. C. Godman Co.*, 28 CCPA 1116, 49 USPQ 381, 383 (1941) the Court held that it could not make a determination as to whether the appellant's mark was a

geographical term, since that matter was not raised below.

b. On the other hand, the CCPA has also affirmed rejections for reasons raised for the first time on appeal.

In several cases the CCPA has admittedly built up reasons for rejection upon portions of prior art patents not mentioned by the Patent Office tribunals to affirm the Board of Appeals. *In re Halley*, 49 CCPA 793, 132 USPQ 16, 20 (1961); *In re Azorlosa*, 44 CCPA 826, 113 USPQ 156, 158 (1957); *In re Hall*, 41 CCPA 759, 100 USPQ 46, 48 (1953); *In re Stinson*, 33 CCPA 853, 69 USPQ 81, 82 (1946). Also, the CCPA held that it was free to combine the references cited by the Board in a manner different from that done by the Patent Office tribunals, *In re Walker*, 51 CCPA —, 139 USPQ 480 (1963); *In re Krammes*, 50 CCPA 1099, 137 USPQ 60, 63 (1963); since it claimed to be relying upon the same teachings. In another case, the CCPA denied having jurisdiction to consider whether appellant was entitled to a hearing below, since he had not made a request for one, but nevertheless proceeded to decide on the merits that the law did not require a hearing. *In re Blood*, 39 CCPA 1037, 197 F. 2d 545, 94 USPQ 189, 191 (1952).

In interference cases the CCPA has willingly strayed even further from the questions decided by the Patent Office tribunals. Where the issue of the right to make the count was raised below, the Court undertook to review a contention con-

cerning the interpretation of that count which was not presented to the Patent Office tribunals in *Bourdon v. Kraft,* 27 CCPA 1408, 46 USPQ 207, 209 (1940). Also, the Court has undertaken on its own initiative to decide the right of a party to make the count and to decide the appeal on that issue, although the issue decided below pertained to priority and neither the Patent Office tribunals nor the parties raised that issue. *Cover v. Schwartz* 28 CCPA 831, 48 USPQ 110, 115 (1941). Similarly, the Court has willingly undertaken to consider a question of unclean hands raised by one of the parties, even though it had not been considered by the Patent Office tribunals. *Whitman Publishing Co. v. McLoughlin Bros. Inc.,* 25 CCPA 1298, 38 USPQ 120, 121 (1938). The Court also decided a question as to the effect upon the proceeding before it of an order of the United States District Court for the Southern District of New York in bankruptcy, where the Patent Office tribunals had expressly refused to decide the matter. *McKesson & Robbins, Inc. (William J. Wardall, Trustee, substituted) v. Leonard James Co.,* 29 CCPA 1137, 54 USPQ 207, 210 (1942). The Court decided a question of diligence which the Patent Office tribunals had refused to determine in *In re Gianladis v. Kass,* 51 CCPA 753, 139 USPQ 300, 305 (1963). After reversing the Board's decision on originality, the CCPA proceeded to decide the question of who was first to reduce to practice, although it had not been determined below. *St. Pierre v. Harvey,* 43 CCPA 918, 110 USPQ 47, 49 (1956).

III. REASONS OF APPEAL

A. "* * * the appellant * * * shall file in the Patent Office his reasons of appeal, specifically set forth in writing * * *." 35 USC 142

1. Are Reasons of Appeal necessary to invoke the CCPA's jurisdiction?

   a. In a recent case, the CCPA held that a failure to include any reasons of appeal in the notice of appeal was a jurisdictional defect and hence could be raised for the first time during oral argument, and dismissed the appeal. *In re LePage's Inc.,* 50 CCPA 852, 136 USPQ 170 (1963).

2. Are reasons of appeal that generally allege that the Board erred in deciding as it did sufficient to invoke the Court's jurisdiction?

   a. The CCPA has held that such general reasons failed to give the CCPA jurisdiction over the cases. *In re Dichter,* 27 CCPA 1060, 45 USPQ 91 (1940); *In re Wesselman,* 29 CCPA 988, 53 USPQ 365 (1942); *In re Gruschwitz et al,* 50 CCPA 1498, 138 USPQ 451 (1963); *In re Timmerbeil et al,* 50 CCPA 1514, 138 USPQ 461 (1963).

   b. The CCPA has also held that such general reasons of appeal were sufficient to give the CCPA jurisdiction over the case appealed, and decided the case on the merits. *In re Kopplin,* 32 CCPA —, 64 USPQ 403, 404 (1945); *In re Arnold and Brandt,* 50 CCPA 1166, 137 USPQ 330 (1963).

B. "* * * the decision [of the CCPA] shall be confined to the points set forth in the reasons of appeal." 35 USC 144

1. Can the CCPA decide upon rejections of claims where all of the reasons for rejection are not specifically listed in the Reasons of Appeal?

   a. Since petitioner did not set forth a Reason of Appeal referring to the Kohring patent in this case, it is pertinent to inquire whether the CCPA could consider that patent.

   b. The CCPA has frequently held that it may not consider reasons for rejection which are not cited in the Reasons of Appeal including designation of the prior art relied upon. As in its decision in *In re Boyce*, 32 CCPA 718, 63 USPQ 80 (1944) the Court has many times not only refused to review a reason of rejection not cited, but it has refused to review the rejection of one or more of the claims before it even when other reasons for rejection were cited, asserting since it could not determine the propriety of the entire rejection, it could consider no part of it. *In re Thomas et al*, 23 CCPA 1238, 30 USPQ 22; *In re Wheeler*, 23 CCPA 1241, 30 USPQ 20; *In re Ferenci*, 23 CCPA 1273, 30 USPQ 50; *In re Rosenblatt*, 28 CCPA 1036, 49 USPQ 117 (1941); *In re Lincoln et al*, 29 CCPA 942, 53 USPQ 40, 44 (1942); *In re Rothenberg and Grimsley*, 29 CCPA 1230, 54 USPQ 417, 420 (1942); *In re Sussman*, 31 CCPA 921, 60 USPQ 538, 540 (1944); *In re Sebald*, 31 CCPA 1148, 62 USPQ 90 (1944); *In re Arter*, 32 CCPA 882, 64 USPQ 563, 566 (1945); *In re Dalzell*

and Wyman, 32 CCPA 938, 65 USPQ 215, 217 (1945); *In re Smith*, 32 CCPA 1256, 66 USPQ 306, 307 (1945); *In re Glocker*, 33 CCPA 826, 68 USPQ 193 (1946); *In re Voit and Weimer*, 33 CCPA 737, 68 USPQ 206, 209 (1946); *In re Scharf*, 33 CCPA 1079, 69 USPQ 518, 519 (1946); *In re Russell*, 34 CCPA 721, 71 USPQ 85, 87 (1946); *In re Emmey and Katzenstein*, 34 CCPA 1097, 74 USPQ 38, 40 (1947); *In re Ray*, 35 CCPA 1088, 77 USPQ 375, 376 (1948); *In re Booge and Seidel*, 37 CCPA 927, 84 USPQ 482, 485 (1950); *In re Strain*, 38 CCPA 933, 89 USPQ 156 (1951); *In re Yuan*, 38 CCPA 967, 89 USPQ 324 (1951); *In re Clark*, 41 CCPA 974, 102 USPQ 241 (1954).

c. By contrast the CCPA has also expressly held that a general reason of appeal is sufficient to bring before its review all of the reasons raised below. *In re Wagenhorst*, 20 CCPA 991, 17 USPQ 330 (1933); *In re Cohen*, 30 CCPA 876, 56 USPQ 567 (1943); *In re Kopplin*, 32 CCPA —, 64 USPQ 403 (1945); *In re Azorlosa*, 44 CCPA 826, 113 USPQ 156 (1957); *In re O'Brien*, 46 CCPA 851, 121 USPQ 461, 463 (1959); *In re Arnold and Brandt*, 50 CCPA 1166, 137 USPQ 330 (1963).

d. The CCPA has also sometimes held that it cannot review specific findings made in the Patent Office unless the findings are specifically cited as error in the Reasons of Appeal. In *Mitchell v. Hennion*, 31 CCPA 1129, 62 USPQ 81, 87-88 (1944); *In re Bergen*, 28 CCPA 1184, 49 USPQ 749 (1941); *Yeates v. Baer*, 31 CCPA 1172, 62 USPQ 157 (1944); *In re Muller*, 20

CCPA 1162, 65 USPQ F. 2d 169, 18 USPQ 24, 25 (1933); *In re Britton*, 28 CCPA 726, 47 USPQ 265, 269 (1940); *Prahl & Mathes v. Redman*, 28 CCPA 937, 48 USPQ 568, 571-572 (1941); *In re Isler*, 33 CCPA 791, 68 USPQ 198, 202 (1946); *In re Tamarin*, 38 CCPA 872, 88 USPQ 490 (1951); *In re Lundberg and Zuschlag*, 44 CCPA 909, 113 USPQ 530, 533 (CCPA 1957)

e. The CCPA has also refused to consider contentions of the parties which were not set forth in the Reasons of Appeal. *Derby Oil Co. v. White Star Refining Co.*, 20 CCPA 816, 16 USPQ 297, 298 (1933); *In re Jacobi*, 17 USPQ 369, 370-371 (1933); *In re Lawson*, 22 CCPA 1016, 24 USPQ 419, 421 (1935); *In re Newsome*, 26 CCPA 750, 41 USPQ 93, 96 (1938); *Saunders v. Browne*, 28 CCPA 884, 48 USPQ 465, 470-471 (1941); *The Penetrene Corp., etc. v. Plough, Inc.*, 29 CCPA 1029, 53 USPQ 638, 642 (1942); *In re Hansen*, 31 CCPA 992, 61 USPQ 119, 122 (1944); *In re Goldberg*, 35 CCPA 1225, 78 USPQ 69, 73 (1948); *In re Irmscher*, 36 CCPA 767, 80 USPQ 136, 138 (1948); *Kruger v. Resnick*, 39 CCPA 994, 94 USPQ 65, 68 (1952); *In re Blood*, 39 CCPA 1037, 94 USPQ 189, 191 (1952); *In re Chaplin*, 44 CCPA 941, 114 USPQ 157, 160 (1957); *In re Gray*, 45 CCPA 777, 116 USPQ 411, 413 (1958); *Tolle and Ludy v. Starkey*, 45 CCPA 979, 118 USPQ 292, 294 (1958); *In re Griner*, 48 CCPA 852, 129 USPQ 61, 63 (1961).

IV. "UPON ITS DETERMINATION THE COURT SHALL RETURN TO THE COMMISSIONER A CERTIFICATE OF ITS PROCEEDING AND DECISION, WHICH SHALL BE ENTERED OF RECORD IN THE PATENT OFFICE AND GOVERN THE FURTHER PROCEEDINGS IN THE CASE." 35 USC 144

Although there has been reasonable uniformity in the interpretations as to the effect of decisions handed down on appeal, it is nevertheless worthwhile to consider some of the leading cases so as to bear in mind this important aspect of that jurisdiction. Judge Cranch in *Arnold v. Bishop et al*, 1 Fed. Cas. 1168, at 1170, Case No. 553 (1841), described it as follows:

> "The words of the Act are, that the judge's decision 'shall govern the further proceedings of the Commissioner in such case.' This must apply only to so much of the case as is involved in the reasons of appeal; and the appeal itself can be considered only as an appeal to so much of the decision of the Commissioner as is effected by such reasons. If, therefore, after the judge shall have decided in favor of the applicant upon the points involved in his reasons of appeal, other sufficient reasons remain for refusing the claim for a patent untouched by the decision of the judge, it would seem that the Commissioner might properly still reject it. Whether such new rejection would be subject to appeal, is a question which may be left, as well as the effect of the judgment of the judge, in regard to the subsequent proceedings of the Commissioner to future decisions, as the case may arise, requiring a decision upon these points."

The Court of Customs and Patent Appeals has held that its jurisdiction is precisely the same as the jurisdiction of the Court of Appeals for the District of Columbia

and its predecessors in appeals from the Patent Office prior to the Act of March 2, 1929. *In re Mavrogenis*, 13 USPQ 25. Upon rehearing in *In re Tucker et al*, 12 USPQ 131, at 134, the court stated:

> "By the reversal of the Board of Appeals we do not mean to suggest the patentability or non-patentability of the claims, and hold only that they are patentable as far as the Miller reference is concerned."

More recently, in an interference case, an appellant argued that if the court dismissed the appeal it would impliedly sanction and authorize the Commissioner of Patents to issue a patent, but the court rejected that contention stating that the effect of their decision

> "* * * is to remand that the cases involved to the Patent Office for further proceedings consistent with the court's opinion. * * * Accordingly, the dismissal of this appeal would in no sense be an approval of the holding of the Patent Office that the count here involved is patentable."

Glass v. DeRoo, Winchester, and Kietzmann, 44 CCPA 723, 112 USPQ 62, 64 (1956).

Two years after the decision in *Glass v. DeRoo, supra*, the court heard an appeal from a decision of the Board of Appeals rejecting the claims in the case entitled *In re Citron*, 45 CCPA 773, 116 USPQ 409. The court reversed the rejection by the Patent Office tribunals. After return to the Patent Office, a notice of allowance was issued but shortly thereafter it was withdrawn and the application was reconsidered. Upon reconsideration, four new references were cited against the application and all of the claims were rejected again. On appeal the second time, the Court of Customs and Patent Appeals sustained the rejection of the Board of Appeals. *In re Citron*, 51

CCPA 869, 140 USPQ 220 (1964). On the second appeal, the appellant charged that the previous decision was controlling as to the appellant's right in a patent on the claims, arguing that prior cases to the contrary were bad law. At 140 USPQ 220-221 the court rejected that contention stating as follows:

> "* * * We do not agree that that opinion states 'bad law'. We do, however, find three of appellant's assumptions to be seriously in error. The first is that in our former decision in this case we held that the application at bar contained 'patentable subject matter' and the other two are that we held the application to be 'allowable', thus 'directing the United States Patent Office to issue a patent.' In deciding appeals from the board in patent cases we do none of these things. All we do is pass on the propriety of the rejections brought before us for review. These cases are not of the type in which the concept of 'double jeopardy' has any applicability."

The significance of those decisions is highlighted by contrasting the jurisdiction of the CCPA with that of the district court as set forth in 35 USC 145 which states that:

> "Such adjudication shall authorize the Commissioner to issue such patent * * *."

The authority of the district court to authorize the issuance of a patent was discussed at length, along with a comparison to the effect of CCPA decision, and a decision of the United States Supreme Court in the *Hoover Co. v. Coe, Com'r. Pats.*, 65 USPQ 180. The decision of the Supreme Court in *Hill v. Wooster*, 132 U.S. 693, set forth the obligation of the district court to review the patentability of counts in interference on the ground that its decision would constitute the sanction of the court as to the patentability of those claims due to the authority granted to authorize the issuance of a patent. The ques-

tion of the patentability of counts in interferences is a matter which the Court of Customs and Patent Appeals has consistently refused to consider as being beyond its jurisdiction. For further comparison between the jurisdiction of the Court of Customs and Patent Appeals in appeals from the Patent Office and the courts of the District of Columbia in civil actions against the Commissioner see *Chase et al v. Coe, Com'r. Pats.*, 49 USPQ 590 (Ct. Appls. D.C. 1941); *General Electric Co. v. Hygrade Sylvania Corp.*, 61 USPQ 263 (D.C. S.N.Y. 1944); and *The Jeffrey Mfg. Co. v. Kingsland, Com'r. Pats.*, 83 USPQ 494 (Ct. Appls. D.C. 1949).